

Appl. No. 10 520 842  
Amdt. dated June 13, 2006  
Reply to Office action mailed December 13, 2005

## REMARKS/ARGUMENTS

The abstract and the specification have been amended to delete the term “consisting” from the description of components (B-1) and (D). The typographical error noted by the Examiner has been corrected and claim 4 has been amended to correct typographical errors. Claim 1 has been amended to delete “comprising” since the term is not necessary in the absence of the term “consisting”. Paragraph [0046] of the published application (US 2005 0245648 A1) states that “[T]he organic phosphorous compound of the present invention is a mixture of (d<sub>1</sub>) . . . and (d<sub>2</sub>) . . . . The use of the term “consisting” in the specification and claims was not intended to limit the scope of the claims. Applicant submit that the deletion of either “consisting” or “comprising” does not add any new matter to the specification or the claims.

Applicants submit that the deletion of the term “consisting” in the specification does not add any new matter or broaden the scope of the specification. New matter is new and substantive information which might change the invention. Deletion of the term does *not* add any new information to the specification. Moreover, Applicants note that the ordinary meaning of “consisting of” (e.g., “composed of” or “made up of”) does not have the restrictive legal meaning given to the term when used in the claims of a U.S. patent application.

There is nothing in Applicants' specification that teaches that the monomer mixture of component (B) is or must be limited only to the monomers recited for (b<sub>1</sub>) and (b<sub>2</sub>) as part of the invention. The rubber modified vinyl-grafted copolymers of component (B), their properties, and the monomers used to form such graft copolymers are well known to one skilled in the art. What is conventional or well known to one of ordinary skill in the art need not be disclosed in detail. If a skilled artisan would have understood the inventor to be in possession of the claimed invention at the time of filing, even if every nuance of the claims is not explicitly described in the specification, then the adequate description requirement is met. (See MPEP §2163). Applicants submit that one skilled in the art would have understood the Applicants to be in possession of the claimed invention from the specification.

The amendment removing the term “consisting” is for the purposes of clarifying what is inherently disclosed in the specification regarding well known rubber modified graft copolymers.

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Applicant submit that the deletion of the term “consisting” does not add any new matter to the specification or the claims.

### **Status of the Claims**

Claims 1- 7 are pending and under consideration.

### **Statement of the Rejections**

Claims 1- 7 stand rejected under 35 U.S.C. §112, first paragraph as failing to comply with the written description requirement. The Examiner has taken the position that deletion of the phrase “consisting of” and insertion of the term “comprising” is new matter.

Claims 1 - 7 stand rejected under 35 U.S.C. §103 as unpatentable over “Bayer AG DE 100 61 081 with Eckel et al. 6,914,089 serving as its English translation”. The references relate to polycarbonate compositions containing a combination of phosphate compounds which include phosphazenes of formula (VI a) which are linear and monomeric cyclic phosphazenes of formula (VI b). Although biphenyl is listed as a possible group for X in Eckel et al., there is no specific disclosure of Applicants’ component (d<sub>2</sub>), biphenyl phosphate esters of Formula (IV). The Examiner has taken the position that “[I]t would have been obvious . . . to select applicants’ flame-retardants from a list of equivalents”.

Claim 1 - 7 stand rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over the claims of commonly owned U.S.6,630,524 (Lim et al.). Lim et al. disclose polycarbonate compositions containing monomeric cyclic phosphagen compounds in admixture with linear phosphagen compounds. There is no specific disclosure of Applicants’ component (d<sub>2</sub>), biphenyl phosphate esters of Formula (IV). The Examiner has taken the position that Applicants’ claimed compositions are not patentably distinct from the claims of Lim et al.

### **Applicants' Traversal**

Applicants traverse the rejections and respectfully request reconsideration in view of the following discussion.

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The term “comprising” has been deleted to expedite prosecution. The deletion of “consisting” was sufficient without the addition of the term “comprising” to remove the unnecessary and unintended limitation of the claims in the U.S. application. As discussed previously, deletion of the term “consisting” does *not* add any new information to the specification. Moreover, the ordinary meaning of “consisting of” (e.g., “composed of” or “made up of”) does not have the restrictive legal meaning given to the term when used in the claims of a U.S. patent application. Applicants’ specification describes the claimed subject matter in conformity with 35 U.S.C. §112.

**The claims are not *prima facie* obvious over Eckel et al. because the reference does not disclose Applicants’ phosphazene component.**

The phosphazene compounds disclosed in Eckel et al. in col. 12, lines 1-30 are monomeric compounds. The phosphazenes of Eckel et al. do not include oligomeric phosphazenes. There is nothing in the reference which teaches or suggests the use of oligomeric phosphazene compounds. Therefore, the reference does not support a *prima facie* case of obviousness.

**Lim et al. do not disclose the use of oligomeric phosphazene compounds in their compositions.**

The cyclic phosphagen, i.e., phosphazene, compound of Lim et al. is also monomeric. There is nothing in the reference teaches or suggests the use of oligomeric phosphazene compounds as those of Formula (IV) in Applicants’ claimed composition. Therefore, Applicants submit that the claims in the present application are patentable over the claims of commonly owned Lim et al.

**The dependent claims also require oligomeric phosphazenes which are not disclosed by either Eckel et al. or Lim et al.**

The dependent claims are not *prima facie* obvious over Eckel et al. or unpatentable over commonly owned Lim et al. since the claims all require the oligomeric phosphazenes of Formula (IV). As discussed previously, the references disclose the use of monomeric phosphazenes. There

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is no teaching or suggestion of the use of oligomeric phosphazenes such as those of Formula (IV).

Applicants submit that a review of the prior art of record as a whole shows that the claims in the present application meet the requirements for patentability. It is respectfully requested that the Examiner reconsider his rejections of the claims and allow claims 1 to 7.

Respectfully submitted,

BY

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